CASE: LA0112 NP...



CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Burton Rodney

Type or print name

ignature

Septenle 26 rod

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ART UNIT: 1626

TIMUR GUNGOR, ET AL.

EXAMINER: STOCKTON, LAURA LYNNE

APPLICATION NO: 10/775,742

FILED: 02/10/2004

FOR: NOVEL THIAZOLIDINE COMPOUNDS AS CALCIUM

SENSING RECEPTOR MODULATORS

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

DECLARATION OF PRIOR INVENTION OF TIMUR GUNGOR AND JOHN K. DICKSON, JR. TO OVERCOME CITED U.S. PATENT NO. 6,673,821

To the Commissioner for Patents and Trademarks:

- 1. This Declaration is to establish reduction to practice of the invention in this application at a date prior to October 22, 2001, that is the filing date of U.S. application Serial No. 10/007,342, now U.S. Patent No. 6,673,821 to Wang et al.
 - 2. Timur Gungor and John K. Dickson, Jr. declare as follows.
- 3. That at the time of the conception and reduction to practice of the invention in the subject application, they each had a Ph. D in Organic Chemistry and were employed as chemists by Bristol-Myers Squibb Company, the assignee of the subject application as evidenced by an

assignment signed by each and recorded at the U.S. Patent and Trademark Office on July 13, 2004, Reel 014844, Frame 0440 (ATTACHMENT I).

- 4. That they are the inventors of the invention claimed in U.S. patent application Serial No. 10/775,742 filed February 10, 2004.
- 5. That the invention defined in the claims as filed was conceived and reduced to practice in the United States prior to October 22, 2001.
- 6. That prior to October 22, 2001, Timur Gungor and John K. Dickson, Jr. conceived of a genus of compounds covered by the claims of the subject application and which includes the compound selected for prosecution in the subject application, that is, the compound prepared in Example 1 of such application (also identified as BMS 515,832), which conception was recorded by Timur Gungor as CaR Program TG Propositions each dated prior to October 22, 2001 and CaR Target, copies of which are attached hereto and identified as ATTACHMENTS A and B, respectively.
- 7. That prior to October 22, 2001, the compound of Example 1 of the subject application was tested under the supervision of Dr. Ramakrishna Seethala for its activity as a modulator of the calcium sensing receptor and found to have such activity, which thereby was a reduction to practice of a species of the genus of the invention (Example 1) as claimed in Claim 1 of the subject application.
- 8. That prior to October 22, 2001, experiments were carried out by Ying Chen under the supervision of Timur Gungor to prepare compounds covered by the claims of the subject application, including the compound of Example 1 which experiments were recorded in Bristol-Myers Squibb Notebook No. 48255 cover page (ATTACHMENT C) and pages 101, 102, 103, 104, 105 and 108, copies of which pages are attached hereto and identified as ATTACHMENTS D, E, F, G, H and I', respectively.

9. On Notebook page 48255-101 (hereinafter page 101) (ATTACHMENT D), entitled Proj. No. 08001, Ying Chen recorded the preparation of intermediate

from Boc-D-thiazolidine-4-carboxylic acid, which experiment he carried out prior to October 22, 2001.

Page 101 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001.

10. On Notebook page 48255-102 (hereinafter page 102) (ATTACHMENT E), entitled Proj. No. 08001, Ying Chen recorded the preparation of the chloride intermediate

prepared from the intermediate prepared as recorded on page 101 (ATTACHMENT D), which experiment was carried out prior to October 22, 2001.

Page 102 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001.

11. On Notebook page 48255-103 (hereinafter page 103) (ATTACHMENT F), entitled Proj. No. 08001, Ying Chen recorded the preparation of the intermediate

prepared from the chloride intermediate prepared as recorded on page 102 (ATTACHMENT E), which experiment was carried out prior to October 22, 2001.

Page 103 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001.

12. On Notebook page 48255-104 (hereinafter page 104) (ATTACHMENT G), entitled Proj. No. 08001, Ying Chen recorded the preparation of the intermediate

prepared from the intermediate prepared as recorded on page 103 (ATTACHMENT F), which experiment was carried out prior to October 22, 2001.

Page 104 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001.

13. On Notebook page 48255-105 (hereinafter page 105) (ATTACHMENT H), entitled Proj. No. 08001, Ying Chen recorded the preparation of the intermediate

prepared from the intermediate prepared as recorded on page 104 (ATTACHMENT G), which experiment was carried out prior to October 22, 2001.

Page 105 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001.

14. On Notebook page 48255-108 (hereinafter page 108) (ATTACHMENT I'), entitled Proj. No. 08001, Ying Chen recorded the preparation of the compound of Example 1 of the subject application

prepared from the intermediate prepared as recorded on page 105 (ATTACHMENT H), which experiment was carried out prior to October 22, 2001.

Page 108 was signed by Ying Chen and witnessed by Hao Zhang, prior to October 22, 2001 (ATTACHMENT I').

- 15. That prior to October 22, 2001, a sample of the compound of Example 1 (BMS 515,832) of the subject application was sent to the Department of Pharmacology to Dr. Ramakrishna Seethala for testing of such compound as a modulator of the calcium sensing receptor as indicated by the compound registration paper (ATTACHMENT J).
- 16. In Notebook No. 49,513, pages 079 to 081, 083 and 084(ATTACHMENTS K through Q), entitled CaR response in TT cells (Table of Contents), Zhengping Ma, under the supervision of Dr. Ramakrishna Seethala, recorded experiments concerning the testing of the compound of Example 1 (referred to as BMS 515,832) as a modulator of the calcium sensing receptor.

Notebook No. 49,513, pages 079 to 081, 083 and 084 were signed by Zhengping Ma and witnessed by Yong Quan prior to October 22, 2001.

17. The testing of the compound of Example 1 for its activity in modulating the calcium sensing receptor was carried out employing the following procedure:

Calcium Receptor Inhibitor Assay Methods:

Inhibition of intracellular calcium:

Calcilytic activity was measured in human TT cells (ATCC No. CRL-1083) by determining the IC50 of the test compound for blocking increases in intracellular Ca2+ by extracellular Ca2+ (as agonist of the receptor). Intracellular Ca2+ was measured using Fluo3,AM (Molecular probes, # F-1242) as indicator dye. Intracellular Ca2+ increase was measured with extracellular Ca2+ from 0.5 to 5 mM in Fluoescence Imaging Plate Reader (FLIPR) (Molecular Devices).

The Ca2+ receptor inhibitor assay procedure is as follows: TT cells were maintained in T-150 flasks in cell growth medium (F-12K Nutrition Media (Gibco 211270-022) with 10% heat inactivated FBS, and 1x Glutamax) in 5% CO₂:95% air at 37°C to 90% confluency. The medium was removed, the cell monolayer was washed with phosphate buffered saline (PBS), incubated with 0.05% trypsin at 37°C for 2 minutes and the cells were dispensed by agitation. Cells from 2 flasks were pooled and centrifuged (200xg). The cell pellet was suspended in cell growth medium. Cells were plated 30,000 cells/well for 2 days, or 24,000 cells/well for 3 days in 96-well black view plates (Falcon, VWR#624-06-468) and incubated in 5% CO₂:95% air at 37°C. Cell medium was aspirated, and cells were loaded with Fluo3 (Molecular Probes, 50 μg dissolved in 25 μ1 DMSO, 50 μ1 20% Pluronic Acid) in base buffer (10 mM HEPES buffer containing 1x Hank's salt, 0.1% BSA, 0.05% D-glucose, 0.8 mM CaCl₂) or 1 hour in a 37°C incubator. After incubation, loading buffer was aspirated and 120 ul/well base buffer was added.

Drug plates were prepared in base buffer and loaded into FLIPR.30 ul from drug plate was added to the cell assay plate and fluorescence signals were read in FLIPR. Drug plate was replaced with CaCl₂ plate in FLIPR plate draw and 30 ul CaCl₂ (1.7 mM final for IC50s, or 2.0 mM for screening) was added into cell plate by FLIPR. The fluorescence signal was measured by reading at 1 second intervals for 30 seconds and at 3 second intervals for the next 150 seconds. Calcilytic activity of the compounds was measured by their ability to block, in a concentration dependent manner (half-log concentrations in triplicate), the intracellular Ca2+ level by extracellular 1.7 mM Ca2+. The data was processed by ActivityBase (IDDBS) and the IC50 values are determined by protocols developed.

18. A summary of the test results obtained by Zhengping Ma, prior to October 22, 2001 and recorded in Notebook No. 49,513, pages 079 to 081,083 and 084 prior to October 22, 2001,

working under the supervision of Dr. Ramakrishna Seethala, is set out in a summary sheet (ATTACHMENT R) prepared subsequent to October 22, 2001.

- 19. The actual dates of Experiments regarding the preparation of the Example 1 compound recorded in Notebook No. 48255-101, 102, 103, 104, 105, 108 were carried out and the dates of signing by Ying Chen and witnessing by Hao Zhang, were all prior to October 22, 2001, but have been obliterated.
- 20. The actual dates of Experiments regarding the testing of the Example 1 compound recorded in Notebook No. 49,513 were carried out and the dates of signing by Zhengping Ma and witnessing by Yong Quan, were all prior to October 22, 2001, but have been obliterated.
- 21. The above clearly establishes conception and reduction to practice of the invention covered by the relevant claims of the subject patent application (vis-à-vis U.S. Patent No. 6,673,821) prior to October 22, 2001.
 - 22. This Declaration is submitted prior to Final Rejection.
- 23. The undersigned declares further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of application Serial No. 10/775,742 or any patent issued thereon.

Date: 09/20/06



UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231



JULY 14, 2004

PTAS

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BRISTOL-MYERS SQUIBB COMPANY STEPHEN B. DAVIS PATENT DEPARTMENT P.O. BOX 4000 PRINCETON, NJ 08543-4000

UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 07/13/2004

REEL/FRAME: 014844/0440

NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

GUNGOR, TIMUR

DOC DATE: 03/23/2004

ASSIGNOR:

DICKSON, JOHN R., JR.

DOC DATE: 03/15/2004

ASSIGNEE:

BRISTOL-MYERS SQUIBB COMPANY
LAWRENCEVILLE-PRINCETON ROAD
PRINCETON, NEW JERSEY 08543-4000

SERIAL NUMBER: 10775742

FILING DATE:

PATENT NUMBER:

ISSUE DATE:

TITLE: NOVEL THIAZOLIDINE COMPOUNDS AS CALCIUM SENSING RECEPTOR MODULATORS

014844/0440 PAGE 2

SHARON LATIMER, EXAMINER ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS

ASSIGNMENT

We,

Timur Gungor residing at 33 Chicory Lane

Pennington, New Jersey 08534

United States of America

John K. Dickson, Jr. residing at 2324 Walden Creek Drive

Apex, North Carolina 27523 United States of America,

pursuant to contractual obligations heretofore assumed by us and/or for good and valuable consideration, the receipt and adequacy of which is hereby acknowledged, do hereby sell and assign to **Bristol-Myers Squibb Company**, a Delaware corporation, having a place of business at Lawrenceville-Princeton Road, Princeton, NJ 08543-4000, its successors, assigns and legal representatives, all our right, title and interest, which includes the right to and full benefit of such priorities as may now or hereafter be granted to us by local laws or by treaty, including any international convention for the protection of industrial property, in and for all countries of the world, including the United States and its territories and possessions, in and to the invention entitled:

Novel Thiazolidine Compounds as Calcium Sensing Receptor Modulators

invented by us and described in the non-provisional United States patent application

Application No. 10/775,742, filed February 10, 2004.

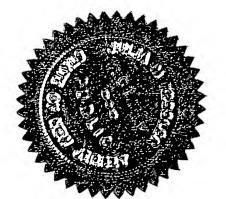
including said non-provisional United States patent application and any application claiming priority from said non-provisional application, filed in any country, and any patents which may be issued and/or granted thereon, and all divisions, continuations, reissues, reexamination certificates and extensions thereof in all countries, the said interest being the entire ownership of said invention and all of said applications, patents (including reissue patents), extensions and reexamination certificates to be held and enjoyed by the said Bristol-Myers Squibb Company and its successors and assigns to the full end of the terms to which said patents (including reissue patents), extensions and reexamination certificates may be granted and/or issued, as fully and entirely as the same would have been held and enjoyed by us if this sale, assignment and transfer had not been made;

And we hereby agree to communicate to said assignee or its representatives any facts known to us respecting said invention, to testify in any legal proceedings, to sign and/or execute any further documents and/or instruments which may be necessary, lawful and proper in and/or for the filing and/or prosecution of all applications, including divisional, continuation and reissue applications, extensions and reexamination certificates and/or the granting and/or issuance thereof and/or to otherwise secure title to said invention and all of said applications, patents (including reissue patents, extensions and reexamination certificates in said assignee, and in general to do everything possible to aid said assignee, its successors and assigns to obtain and enforce proper protection for said invention in all countries.

Signed this 23d day of Horch, 2004 by Timer Gungor

STATE OF New) ss.

On the 23 day of Mach , 2004, before me came Timur Gungor, to me known to be the person of that name mentioned in, and who executed the foregoing Assignment and acknowledged that he/she executed it.



Notary Public Notary Public

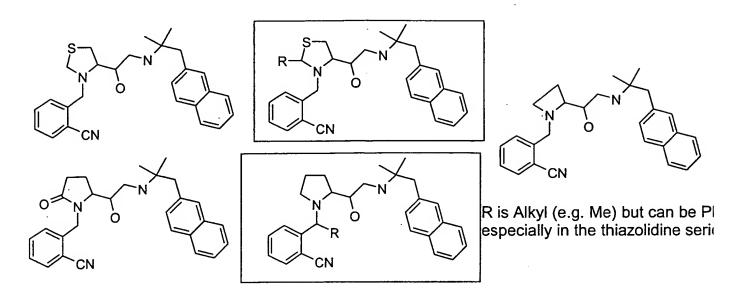
Julia Mary Kessler
My Commission Expires

December 20, 2008

Signed this 15th day of March, 2004 by John K. Dickson, Jr.
STATE OF North Cavolina)
STATE OF North (avoluna)) ss. COUNTY OF Wake)
On the 15th day of March , 2004, before me came John K. Dickson Jr., to me known to be the person of that name mentioned in, and who executed the foregoing Assignment and acknowledged that he/she executed it.
[SEAL]
my commission experies Notary Public 12/25/2006
12/25/2006

CaR PROGRAM TG Propositions

IDEAS WHITIN THE BOX:



IDEAS OUT OF THE BOX:

1) **Observation**: The phenyl of the Benzyl substituent is not fitting as good as it should be.

IDEA: Compounds with constrained phenyl ring in this part of the molecule

$$\begin{cases} \begin{pmatrix} 1 & 1 \\$$

ATTACHLIGHT A

CaR Target

Prepare ~ 50mg or these compounds:

The reaction scheme could be the following:

The conditions for each step, by default, are those used for Proline series. Meta CN and/ or differently substituted benzyles are to be considered according to the SAR on the Proline series.

Other modifications on the Thiazolidine ring will be made after the biology results for this two compounds.

Ref: Tetrahedron Asymmetry 9 (1998) 4249-4252

1.

J. Org. Chem. Vol. 62 No 14 (1997) p. 4770-4779

Tet.Let. Vol. 38 No 18 (1997) p. 3175-3178

ATTACTMENT B



BRISTOL-MYERS SQUIBB

NOTEBOOK N_0 . 48255

Assigned to Ying Chen
Subject
Department Name
Department Number
Date Assigned
Date Completed
Pages Completed from to
Continued from Notebook Number
Continued in Notebook Number

This notebook cannot be transferred to another person

ATTACHHENT C

ATTACHMENT D

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Bristol Myers Squibb - Pharmaceutical Research Institute COMPOUND REGISTRATION PROPRIETARY - CONFIDENTIAL

PART 1 - Registry Office Use

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BRISTOL-MYERS SQUIBB

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ATTACHMENT K

TABLE OF CONTENTS

PRODUCT OR SUBSTANCE STUDY PERFORMED OR OBJECTIVE

JC50s; BMS-515832:02-002,/280429; 280587

TT cells, plated ou ar 24,000 cells/well used (see also 49513-068)

0.8 mM Caribasal, 1.7 mM Caristimulation.

See also 44676-072 for basic protocol

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Signal Test (2)
Plate 1: ZMCa072601a_n0,
Minimum 9045.6: 16.47%
Average 10829.4

Maximum-12823.2 STDEV:/...738.3

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NOTEBOOK No.

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Protocol ID: Study ID:

MDCaR010726-1 CaR_H_IC58 CaR Zhengping Ma

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		Molecular Wt	445.63	Location	HW	Amount (MG	82.0		isomer B	Biologist's Notebook			MD_PPAR	Result Comments		•
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